

### REMARKS

Claims 1-2, 4-11, 13-16, 18-20, and 22-31 are pending.

Claims 3, 12, 17, and 21 have been cancelled.

In the Final Rejection dated March 10, 2010, claims 1, 2, 4-11, 13-15, and 24-30 were rejected under 35 U.S.C. § 103(a) as unpatentable over McCulloch (U.S. Patent No. 2,894,587) in view of Maloney (U.S. Patent No. 4,708,595); and claims 16, 18-20, 22, 23, and 31 were rejected under 35 U.S.C. § 103(a) as unpatentable over McCulloch in view of Maloney and further in view of Wellington (U.S. Patent No. 5,031,697).

It is respectfully submitted that the obviousness rejection of claim 1 over McCulloch and Maloney is erroneous.

To make a determination under 35 U.S.C. § 103, several basic factual inquiries must be performed, including determining the scope and content of the prior art, and ascertaining the differences between the prior art and the claims at issue. *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 U.S.P.Q. 459 (1965). Moreover, as held by the U.S. Supreme Court, it is important to identify a reason that would have prompted a person of ordinary skill in the art to combine reference teachings in the manner that the claimed invention does. *KSR International Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741, 82 U.S.P.Q.2d 1385 (2007).

The Office Action conceded that McCulloch fails to disclose a plurality of gas lift valves attached to a tubular member, where the tubular member is part of a gas injection tool that is separate from and not in contact with a tubing string for removing fluid from the wellbore. 3/10/2010 Office Action at 4. Instead, the Office Action cited Maloney as purportedly disclosing the plurality of gas lift valves recited in claim 1. *Id.* Specifically, the Office Action pointed to the gas lift valves 30 depicted in the figure of Maloney.

The valves 30 in Maloney are unloading valves. Maloney specifically teaches that these unloading valves 30 are part of the production string 21. Maloney, 3:28-32 (“The production string 21 further includes unloading valves 36 above the packer 18 and unloading valves 30 below the packer.”). The teachings of Maloney thus contradict the subject matter of claim 1, which specifically specifies that the gas lift valves are attached to the tubular member of a gas injection tool that is **separate from and not in contact** with a tubing string for removing fluid from the wellbore.

McCulloch discloses a tubular extension member 40 (*see* Figs. 1 and 2 of McCulloch) that has an opening at its bottom end, but no gas lift valves. On the other hand, Maloney discloses unloading valves 30 that are part of the main production string 21, and provides no hint whatsoever regarding providing gas lift valves attached to a tubular member that is separate from and not in contact with the main production string 21 for removing fluid from the wellbore.

In view of the foregoing, it is clear that even if McCulloch and Maloney could be hypothetically combined, the hypothetical combination of these references would not have disclosed or hinted at all elements of claim 1.

In addition, no reason existed that would have prompted a person of ordinary skill in the art to combine the teaching of McCulloch and Maloney to achieve the subject matter of claim 1. In fact, specific reasons exist that would have led a person of ordinary skill in the art away from the proposed combination.

First, McCulloch specifically discloses valves 44 and 45 provided at the upper end of the tubular extension member 40. McCulloch recognizes that no valves can be provided at the lower portion of the tubular extension member 40 because such lower portion of the tubular extension member 40 has to be provided through a passageway 30 of a packing member 23 (*see* Figure 1 of McCulloch). Significantly, note that the tubular extension member 40 is designed to be sealingly engaged inside the passageway 30 (*see* sealing element 41 in Figure 2 of McCulloch), and is also designed to be retrievable by a fishing tool 71 (*see* Figure 3 of McCulloch). McCulloch, 3:26-32. If gas lift valves were to be incorporated into the lower portion of the tubular extension member 40 of McCulloch, as suggested by the Office Action, then that would render it impossible for the tubular extension member 40 to pass through the passageway 30 of the packing member 23, since provision of such gas lift valves would increase the outer diameter of the tubular extension member 40. Therefore, the proposed modification of McCulloch made by the Office Action would render the McCulloch apparatus inoperative for its intended purpose (namely provision of a tubular extension member that is sealingly engageable inside the passageway 30 of the packing member 23, and that is retrievable by passing through such passageway 30). This is a strong indication that a person of ordinary skill in the art would not have been prompted to make the modification of McCulloch based on the teachings of Maloney as proposed by the Office Action.

Second, Maloney specifically teaches that its sidestring 28 is in contact with the production string 21, and that the unloading valves 30 are part of the production string 21. A person of ordinary skill in the art would have been led by Maloney to incorporate unloading valves 30 into the main tubing 22 of McCulloch (*see* Fig. 1 of McCulloch), rather than providing unloading valves on the tubular extension member 40.

In view of the foregoing, a person of ordinary skill in the art would have been led away from providing gas lift valves on a tubular member that is part of a gas injection tool that is separate from and not in contact with a tubing string for removing fluid from the wellbore.

Therefore, it is respectfully submitted that claim 1 is non-obvious over Maloney and McCulloch.

Independent claims 7, 13, and 14 are allowable over McCulloch and Maloney for similar reasons as claim 1.

Independent claim 22 was rejected as purportedly obvious over McCulloch in view of Maloney and Wellington. The rejection of claim 22 over these references is defective based on at least the mis-application of McCulloch and Maloney to subject matter of claim 22 similar to the subject matter of claim 1. Claim 22 recites producing fluids from a wellbore using a tubing string that is separate from and not in contact with the injecting tool, where the injecting tool has plural gas lift valves. As discussed above in connection with claim 1, Maloney would have led a person of ordinary skill in the art to provide unloading valves 30 into the main tubing 22 of McCulloch, rather than on the tubular extension member 40, as alleged by the Office Action. Note that Wellington, the third reference, was cited by the Office Action as purportedly disclosing operating valves at different pressures. Wellington does not provide any hint of incorporating gas lift valves into an injecting tool that is separate from and not in contact with a tubing string that produces fluids from the wellbore. Thus, it is clear that even if McCulloch, Maloney, and Wellington could be hypothetically combined, the hypothetical combination of the references would not have led to the claimed subject matter.

Moreover, for reasons similar to those stated above with respect to claim 1, no reason existed that would have prompted a person of ordinary skill in the art to combine the teaching of Maloney and McCulloch. Therefore, no reason existed to combine the teachings of Maloney, McCulloch, and Wellington to achieve the subject matter of claim 22.

Claim 22 is therefore non-obvious over McCulloch, Maloney, and Wellington.

Dependent claims are allowable for at least the same reasons as corresponding independent claims. In view of the allowability of base claims, the obviousness rejection of dependent claims has been overcome.

Allowance of all claims is respectfully requested. The Commissioner is authorized to charge any additional fees and/or credit any overpayment to Deposit Account No. 20-1504 (SHL.0343US).

Respectfully submitted,

Date: May 7, 2010

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